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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,255	07/29/2003	Jae-Hwan Lee	P24011	5430

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EXAMINER

SAADAT, CAMERON

ART UNIT PAPER NUMBER

3713

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/628,255

Applicant(s)

LEE, JAE-HWAN

Examiner

Cameron Saadat

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/29/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/4/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

In response to preliminary amendment filed 7/29/03, claims 1-4 and newly added claims 5-6 are pending in this application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "and/or" in claim 1 provides multiple alternatives and is therefore indefinite. In claim 2-3, the term "Velcro" should be written as -- Velcro™ -- since it is a trademark for hook and loop fasteners.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baer et al. (USPN 5,531,600) in view of Weiner (4,778,391).

Regarding claim 1, Baer discloses a book 102 having a sound generator 100 built therein, comprising: a book body, and a sound generator 100 that can be separated from the book body (Col. 4, lines 50-54), wherein the book body includes a front cover, a rear cover, and a plurality of inner leaves 104 located between the front cover and the rear cover, on which contents to be delivered to a reader are represented in letters, symbols and/or illustrations, wherein the front cover or the rear cover includes a marginal space element at which the sound generator is seated (Col. 4, lines 32-39), and an attachment/detachment means installed at the marginal space element, for separately supporting the sound generator (Col. 4, lines 50-54), a sound storage means for storing sound data corresponding to the contents of each of the inner leaves, a sound output means for outputting the sound data with a sound (Col. 4, lines 57-65), and a control means for controlling the output of the sound data corresponding to the page set in the page setting means to the sound output means (Col. 6, lines 16-26). Baer discloses all of the claimed subject matter with the exception of explicitly disclosing a page setting means and a page display for visually displaying a page set in the page set. However, Weiner discloses a book having a sound generator 4 attached to the book, wherein the sound generator further comprises a display 126 and page setter 127-128 for setting the page number to correlate with the printed page numbers in the book. Hence, in view of Weiner it would have been obvious to one of ordinary skill in the art to modify the sound generator described in Baer by providing a page number setter and page number display in order to allow a user to increment page numbers to retrieve

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stored digital data from the sound generator that corresponds to the page number printed on the respective page of the book.

Regarding claim 4, Baer discloses a book, wherein the marginal space element has a portion larger than the horizontal length of the inner leaves in the rear cover (See Fig 1A).

Claims 2-3 and 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baer et al. (USPN 5,531,600) in view of Weiner (4,778,391), further in view of Sandvik (USPN 5,419,705).

The combination of Baer and Weiner discloses all of the claimed subject matter with the exception of explicitly disclosing an attachment/detachment means consisting of hook and loop fasteners. However, Sandvik discloses a book comprising a sound generating device 58, wherein the sound generating device 58 is attached to the book with hook and loop fasteners 60. Hence, in view of Sandvik, it would have been obvious to an artisan to modify the attachment/detachment means of the sound generator, by providing hook and loop fasteners, in order to allow removal of the sound generator so that it may be used with a multiplicity of different books (See Baer).

Regarding claims 5-6, Baer discloses a book, wherein the marginal space element has a portion larger than the horizontal length of the inner leaves in the rear cover (See Fig 1A).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

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- Padgett (USPN 6,421,524) – discloses a book comprising a audio recording/playback apparatus.
- Kirwan (USPN 6,516,181) – discloses a book comprising a voice recording device.
- Manddrell et al. (USPN 5,803,748) – disclose a book compising an audio device in the margin of the book.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cameron Saadat whose telephone number is 703-305-5490. The examiner can normally be reached on M-F 8:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cf
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JOHN M. HOTALING, II
PRIMARY EXAMINER